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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 85

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

REPLY BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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Petitioner contends that the decision in the instant case by the United States Court of Appeals for the Sixth Circuit conflicts with the decision of the United States Court of Appeals for the Ninth Circuit in *Hycon Manufacturing Company v. H. Koch & Sons,* 219 Fed. (2d) 353. In the Hycon case the District Court granted a motion for summary judgment finding the patent in suit *valid* but was reversed by the Court of Appeals on the ground that sub-

stantial issues of fact remained in the case. The Court stated at 219 Fed. (2d) page 355

> "An indispensable prerequisite to such a judgment is the absence of a material question of fact."

In the instant case the Court of Appeals affirmed the District Court and held the Bobertz patent in suit 1,911,600 *invalid* for want of invention, 228 Fed. (2d) at 101. The Court of Appeals stated, 228 Fed. (2d) 94, at 100

> "Where there was no genuine issue of material fact presented, this court has affirmed a summary judgment for the defendant in a patent case. *Lincoln Electric Co. v. Linde Air Products Co.*, 6 Cir., 171 F. 2d 223."

That this same rule of law is followed by the Court of Appeals for the Ninth Circuit, see *Leishman v. Radio Condenser Co.*, 167 Fed. (2d) 890; *Park-In-Theatres, Inc. v. Perkins*, 190 Fed. (2d) 137.

In the instant case and in the Hycon case the Courts of Appeals for both the Sixth and Ninth Circuits followed the provision of Rule 56 (c) that a motion for summary judgment should be granted

> "* * * if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact * * *."

In the Hycon case the Court found a genuine issue as to material facts whereas in the instant case both the District Court and the Court of Appeals found no genuine issue as to any material fact. Thus, it is evident that there is no conflict in the decisions of the Courts of Appeals for the Sixth and Ninth Circuits.

Long before the adoption of the Federal Rules of Civil Procedure this Court approved summary judgment in patent cases holding the patent in suit void on demurrer where the patent was manifestly void, *Richards v. Chase Elevator Co.,* 158 U. S. 299, 15 S. Ct. 831, 39 Law Ed. 991; *Risdon Iron & Locomotive Works v. Medart,* 158 U. S. 68, 15 S. Ct. 745, 39 Law Ed. 899.

Petitioner and respondent are in agreement that the configuration or form of the accused hood is substantially as shown in petitioner's own Exhibits F and G found at pages 63a and 64a of plaintiff's (Petitioner's) Appendix. Because there is no disagreement as to the form or configuration of respondent's plastic hood, therefore, whether or not the respondent's physical exhibit of the accused display hood is a fair sample and the photographs thereof (Hirshman affidavit Exhibits 8, 9, 10, 11) truly represent the same, are not material facts. Since the Court of Appeals affirmed the District Court on the ground that the Bobertz patent is *invalid* and did not decide the question of infringement (228 Fed. (2d) at 101), respondent's accused hood and the photographs thereof were not at all necessary or material to this decision.

On pages 3, 4 and 5 of his reply brief petitioner quotes from the affidavit of Tjaarda which sets forth Tjaarda's conclusions, opinions and arguments with respect to the prior art relied upon by respondent. Since Tjaarda's affidavit does not set forth facts, it does not conform to Rule 56(e).

The province of an expert was clearly delineated by Judge Learned Hand in *Kohn v. Eimer,* 265 Fed. 900, 902 (C. A. 2) in the following words:

> "At the outset the appellant challenges our right to examine the prior art patents at all, because the

> appellee called no expert at the trial to explain them. *Waterman v. Shipman*, 55 F. 982, 987, 5 C. C. A. 371. We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence."

Because of the extreme simplicity of the transparent automobile hood which is the subject matter of this suit and since the prior art patents and publications relied upon by respondent can be easily comprehended even by a lay person, it is obvious that there is no need for expert testimony in this case and that the Court below properly decided that the patent in suit was invalid as a matter of law, *Market Street Cable Railway Co. v. Rowley*, 155 U. S. 621, 625, 39 Law Ed. 284.

Respectfully submitted,

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